

REMARKS

Claims 61-68 were pending in the present application at the time of the Office Action.

Claims 60-63 stand provisionally rejected on the ground of obviousness-type double patenting as being unpatentable over claims 40, 45 and 57 of co-pending application no. 10/630,138.

Claims 64-68 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The present amendment adds new dependent claims 69-106

For at least the reasons stated below, the Applicants respectfully traverse the above rejections and submit that all pending claims are allowable.

Examiner Interview in Related Case

The Applicants would like to thank the Examiner for the interview of Jan. 8, 2009 for related application 10/657,785. Apart from discussing the details of such application and various references, the parties also discussed co-pending applications 10/630,138 and 10/657,595 and recently issued U.S. Patent No. 7,457,646. The Examiner requested that the Applicants submit terminal disclaimers for such pending applications and issued patent along with a terminal disclaimer to parent patent 5,940,771.

The parties also discussed the ongoing reexamination of U.S. Patent No. 6,374,311 (control no. 90/008,136). Though, as indicated in the Office action mailed Feb. 11, 2008, the Examiner has already considered the references involved in such reexamination, for precautionary reasons, the Examiner expressed an interest in revisiting such references.

Terminal Disclaimers

As discussed previously, during the above-mentioned Examiner Interview, the Examiner requested that the Applicants submit terminal disclaimers for co-pending applications 10/630,138, 10/657,785 and 10/657,595 and U.S. Patent Nos. 7,457,646 and 5,940,771. Though the Applicants do not agree that such terminal disclaimers are necessary, such terminal disclaimers are submitted herewith to expedite prosecution of the present application. Note that

a terminal disclaimer for 5,940,771 was submitted on Jan. 17, 2003 and approved.

6,374,311 Reexamination

As discussed previously, during the above-mentioned Examiner Interview, the parties also discussed the ongoing reexamination of U.S. Patent No. 6,374,311 (control no. 90/008,136). Though, as indicated in the Office action mailed Feb. 11, 2008, the Examiner has already considered the references involved in such reexamination, for precautionary reasons, the Examiner expressed an interest in revisiting such references. For the convenience of the Examiner, copies of the Mobitex Terminal Specification and Battery-Saving Addendum are resubmitted herewith as Exhibits 1 and 2. The Applicants' submission of the Mobitex Terminal Specification and Battery-Saving Addendum should in no way be construed as an admission or concession by the Applicants that such documents constitute or qualify as prior art to the present application. On the contrary, the Applicants maintain the position adopted in the ongoing reexam that such documents are not printed publications and reserve the right to assert that position in the future in any forum or proceeding.

Obviousness-type Double Patenting Rejections

Claims 60-63 stand provisionally rejected on the ground of obviousness-type double patenting as being unpatentable over claims 40, 45 and 57 of co-pending application no. 10/630,138. The Applicants respectfully traverse such rejections.

As mentioned above, though the Applicants disagree with such rejection, to expedite prosecution of the present application, a terminal disclaimer for 10/630,138 is submitted with this response. Accordingly, the Applicants respectfully request that the obviousness-type double patenting rejections be withdrawn.

Objections to the Claims

Claims 64-68 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants respectfully traverse such Objections.

For example, claims 64-68 each depend from claim 61, which as discussed above, is allowable. Since each of claims 64-68 depend from an allowable base claim, the Applicants

submit that claims 64-68 are allowable. The Applicants also submit that each of claims 64-68 is independently allowable.

New Claims

New dependent claims 69-106 have been added by the present amendment. The Applicants submit that such claims are allowable.

Claims 69-106 each depend from claim 61 and are thus allowable for at least the reasons for which claim 61 is allowable. The Applicants also submit that each of claims 69-106 is independently allowable.

Due to the relatively large number of new claims, for the convenience of the Examiner, the Applicants have provided below a table identifying non-limiting exemplary support for each of the new claims. Also for the Examiner's convenience, since the present application is a continuation of issued U.S. Patent No. 5,940,771, the table below refers to the column and line numbers of the '771 patent.

Claim	Non-limiting Exemplary Support in 5,940,771
69	Col. 2, lines 26-31
70	Col. 23, lines 35-44
71	Col. 24, lines 46-48
72	Col. 24, lines 53-55
73	Col. 30, lines 28-41
74	Col. 30, lines 19-23
75	Col. 30, lines 19-23
76	Col. 34, lines 17-18
77	Col. 34, lines 17-18
78	Col. 34, lines 17-18; col. 39, lines 17-23

79	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
80	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
81	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
82	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
83	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
84	Col. 39, lines 17-23; col. 39, lines 40-44
85	Col. 39, lines 17-23; col. 39, lines 40-44
86	Col. 34, lines 17-18; col. 39, lines 17-23; col. 39, lines 40-44
87	Col. 34, lines 34-35
88	Col. 34, lines 39-45
89	Col. 34, lines 39-45
90	Col. 34, lines 39-45
91	Col. 34, lines 11-38; col. 39, lines 40-48
92	Col. 34, lines 11-38; col. 39, lines 40-48
93	Col. 34, lines 11-38; col. 39, lines 40-48
94	Col. 34, lines 11-38; col. 39, lines 40-48
95	Col. 39, lines 44-48
96	Col. 34, lines 11-38; col. 39, lines 40-48
97	Col. 34, lines 11-38; col. 39, lines 40-48; col. 23, lines 35-44
98	Col. 38, lines 8-12
99	Col. 39, lines 21-23
100	Col. 40, lines 3-7

101	Col. 41, lines 46-51
102	Col. 52, lines 52-58
103	Col. 52, line 56 to col. 53, line 2
104	Col. 53, lines 37-42
105	Col. 53, lines 21-25
106	Col. 53, lines 26-30

Final Matters

The Office Action includes various statements regarding pending claims 61-68, pending claims in the 10/630,138 application and obviousness that are now moot in view of the previous discussion. Accordingly, the Applicants will not address all of such statements at the present time. The Applicants neither agree nor disagree with such statements and expressly reserve the right to challenge or support any or all of such statements in the future should the need arise, for example if such statements should become relevant by appearing in a future rejection of any claim (*e.g.*, in the present application and/or a continuation application).

Summary

In summary, for at least the aforementioned reasons, the Applicants submit that the present application is in condition for allowance. Accordingly, the Applicants courteously solicit a Notice of Allowability with respect to all pending claims. If the Examiner has any further questions, the Applicants invite the Examiner to contact the undersigned to discuss such questions.

Appl. No. 09/318,668
Resp. dated Feb. 19, 2009
Resp. to Office Action of Dec. 23, 2008

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: Feb. 19, 2009

Respectfully submitted,

/Shawn L. Peterson/
Shawn L. Peterson
Reg. No. 44,286
Attorney for the Applicants

McANDREWS, HELD & MALLOY, LTD.
500 W. Madison, Suite 3400
Chicago, IL 60661
Telephone: (312) 775-8000